



Docket No. YOR920000779US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Patent Application

Applicant(s): B.D. Silverman
Case: YOR920000779US2
Serial No.: 09/818,461
10 Filing Date: March 27, 2001
Group: 1631
Examiner: Michael L. Borin

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Signature: *[Signature]* Date: October 20, 2003

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15 Title: Spatial Profiling of Proteins Using Hydrophobic Moments

RESPONSE TO RESTRICTION REQUIREMENT AND SPECIES ELECTION

20 Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

25 Sir:

This is in response to the outstanding Office Action dated September 30, 2003 in the above-identified application. Claims 1-43 are currently pending in the application.

30 In the outstanding Office Action, the Examiner required restriction of the application to one of three groups of claims. The Groups, as stated by the Examiner, contain overlapping claims, which Applicant believes reflects an error in the grouping. The present response is thus directed to the following three groups of claims which Applicant presumes were the claim groupings intended by the Examiner: Group I, including claims 1-6, 22-27 and 33-38; Group II,
35 including claims 7-18, 28-32 and 39-43; and Group III, including claims 19-21.

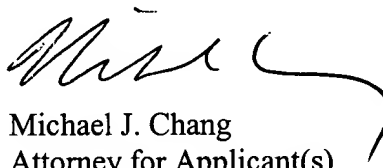
Applicant respectfully asserts that the restriction requirement is improper and should be withdrawn since all the claims in each Group belong to the same class and subclass, namely class 703, subclass 12. Accordingly, Applicant submits that an examination of all three groups would not impose a serious burden on the Examiner. Where, as here, "the search and examination of an

entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP §803.

Accordingly, it is respectfully requested that the restriction requirement be reconsidered and withdrawn and that all of the pending claims in the application be examined together in this application, or, alternatively, Applicant hereby elects Group I, claims 1-6, 22-27 and 33-38, with traverse, for prosecution in this application.

The Examiner has further required the election of a single disclosed species, as is set forth under 35 U.S.C. §121. Applicant hereby elects, without traverse, the species wherein an adjusted second-order moment of hydrophobicity is determined. Applicant submits that claims 5, 26 and 37 of Group I are readable on the elected species.

Respectfully submitted,



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Date: October 20, 2003